

REMARKS

Applicants gratefully acknowledge the phone interview with the Examiner on June 4, 2009, in which she explained that the claims would not be allowed and that an Office Action would follow. See Examiner's Interview Summary dated June 10, 2009, the same date as the Final Office Action now at issue.

Applicants have amended the claims to correct several inadvertent minor errors having no effect on the scope of the claims. In particular, Applicants have amended Claim 37 to relocate the conjunction "and", Claims 37-39 to limit the definitions of A and B taken together and A and D taken together, and Claims 38-40 to delete any reference to Q³ (which is not a defined group in the current claims). Applicants respectfully submit that their claims remain fully supported by the specification. Because Applicants' amendments add no subject matter and should not add to the burden of examination, Applicants respectfully request their entry and consideration.

Applicants again request rejoinder of Claim 61 in view of the Examiner's previous indication in a phone interview on March 13, 2009, that correction of the dependency of Claim 61 to Claim 37 would open it to consideration. See Applicants' Supplemental Amendment dated March 16, 2009, at page 17. Applicants again reserve the right to file one or more divisional applications directed to the canceled subject matter.

Information Disclosure Statement

The Final Office Action provides no indication that certain foreign language references submitted by Applicants have been considered. Applicants again respectfully request consideration of these references and repeat their previous arguments for the convenience of the Examiner.

Applicants are aware of their obligation to include a concise explanation of the relevance of information that is not in the English language. Although English translations or English abstracts are typically used to satisfy this requirement, other methods are also acceptable. See MPEP § 609.04(a)(III) (Concise Explanation of Relevance For Non-English Language Information), which states inter alia (with emphasis added) that

Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-

language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report.

Here, one of the references that was not considered – citation “AT” (i.e., a Beilstein database citation that itself refers to a specific page in a *Justus Liebigs Annalen Chemie* article) at Sheet 13 of 16 of their previously submitted Form PTO 1449 IDS listing – was specifically identified in the International Search Report as a particularly relevant “X” reference. Applicants therefore again submit that this reference must be considered.

According to the MPEP, another way to satisfy the citation requirement is to discuss a reference in the specification and cite it in the IDS listing, with a strong preference (i.e., the phrase “should include”) for identifying “the page(s) or line(s) numbers where the concise explanation is located in the specification.” See MPEP § 609.04(a)(III). The concise statement in the specification can take several forms, including “a simple statement pointing to similarities between the item of information and the claimed invention” with or without a discussion of the differences between the cited information and the claims. See MPEP § 609.04(a)(III). Although Applicants believe it is preferable but not absolutely essential to provide page/line indicators in the IDS listing, they are mindful of the potential burden on the Examiner and therefore again provide the following table showing where the specification discusses each document that was cited but not considered. Applicants note that these documents disclose known compounds, methods of making compounds, and methods of application.

Form 1449 Sheet No.	Label	Brief description (from Form 1449)	Specification location
1	AS	Liebigs Ann. Chem., 1985, pp. 1095-1098	Pg. 1, lines 10-12
2	AR	Arch. Pharm., 309, 1976, pp. 558-564	Pg. 2, lines 8-11
2	AS	Chem. Ber., 91, 1958, p. 2849	Pg. 2, lines 8-11
2	AT	Monatsch, 95, 1964, pp. 147-155	Pg. 2, lines 16-19
5	AT	Schotten-Baumann, Organikum, 1977, p. 505	Pg. 91, line 14, to pg. 92, line 8
6	AR	Houben-Weyl, Methoden ..., 8, 1952, pp. 467-469	Pg. 92, lines 9-12
6	AS & AT	Ann. Chim., [14], 5, 1970, pp. 11-22 and pp. 23-38	Pg. 93, lines 4-6

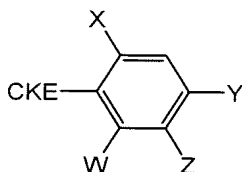
Form 1449 Sheet No.	Label	Brief description (from Form 1449)	Specification location
9	AR	Organikum, 1977, pp. 517-518	Pg. 100, lines 9-12
9	AT	Organikum, 1977, pp. 587-589	Pg. 101, lines 4-12
10	AR	Organikum, 1977, p. 499	Pg. 102, line 19, to pg. 103, line 5
10	AS	Organikum, 1977, pp. 519-521	Pg. 103, line 12, to pg. 104, line 4 <u>and</u> Pg. 106, line 11, to pg. 107, line 7
10	AT	Liebigs Ann. Chem., 1954, pp. 1-15	Pg. 108, line 13, to pg. 109, line 5
11	AR	Reaktionen ..., 1978, pp. 212 and pp. 513-515	Same text as Sheet 10, AT
11	AS	Liebigs Ann. Chem., <u>443</u> , 1925, pp. 242-262	Same text as Sheet 10, AT
11	AT	Chem. Ber., <u>98</u> , 1965, pp. 2551-2555	Same text as Sheet 10, AT
12	AT	Chem. Ind., <u>37</u> , 1985, pp. 730-732	Pg. 148, lines 4-6

Applicants therefore again respectfully request consideration of these additional references.

Rejections under 35 U.S.C. 103

Claims 37-40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,451,843 ("Lieb et al") (which Applicants again note is the PCT counterpart WO 99/55673). Applicants respectfully traverse.

As fully discussed in Applicants' Amendment dated December 3, 2008, Lieb et al discloses compounds having the general formula

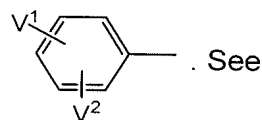


in which **X** can be any of a number of substituents but is never hydrogen; **Y** can be optionally substituted cycloalkyl, aryl, or heteroaryl; **W** can be hydrogen or any of a number of other substituents; **Z** can be any of a number of substituents but is never hydrogen; and **CKE** is one of several cycloketoenol groups, most – but not all – of which are heterocycles. E.g., column 2, line 50, through column 5, line 55. To simplify comparison of the compounds of Lieb et al with their claimed compounds, Applicants again point out that members of group Z of the reference are not found in the definition of group Z of Applicants' formula (I) but are instead found (in part) in

the definition of Applicants' group Y. Conversely, members of group Y of Lieb et al are not found within the definition of Applicants' group Y but instead should be compared with Applicants' group Z. With this correlation in mind, Applicants submit that the differences between group Y of Lieb et al and Applicants' group Z are significant.

In particular, unlike the partial overlap between group Z of the reference and Applicants' group Y mentioned above, Lieb et al does not provide within its teachings about group Y an enabling disclosure of the narrowly defined pyrazolyl or benzpyrazolyl groups specified in Applicants' claims for their group Z. The reference at only one place in the specification (specifically, column 3, lines 1-2) uses the general term "hetaryl" when describing its group Y and even then teaches a clear preference for specific heteroaryl moieties that are structurally different from the pyrazolyl and benzpyrazolyl groups specified for Applicants' group Z (i.e., the group believed closest to group Y of the reference). Compare "Y preferably" at column 29, lines 1 et seq, "Y particularly preferably" at column 35, lines 44 et seq, and "Y very particularly preferably" at column 41, lines 20 et seq. As will also be discussed below with respect to their comparison experiments, Applicants emphasize that Lieb et al teaches that the very most preferred embodiments are those in which its group Y is

an optionally substituted phenyl group having the formula



column 41, lines 35-40. [It may be noted by way of further comment that Lieb et al also does not claim any embodiments in which Y is a heterocyclic group, much less a pyrazolyl or benzpyrazolyl group.] For this reason alone, Applicants believe their claimed invention is patentably distinct from Lieb et al.

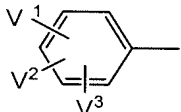
In further support of their position, Applicants submitted comparison data in the form of Declarations under 37 C.F.R. 1.132 of Dr. Heinz Kehne and Dr. Olga Malsam, respectively. The Final Office Action, however, asserts that the comparisons are not the closest possible comparison and thus maintains the obviousness rejection. Applicants respectfully submit that their comparison data are both appropriate and persuasive.

First, Lieb et al, although it refers generally to compounds in which its group Y can be a heterocycle (as mentioned above), emphatically does not teach that its group Y can be pyrazolyl or benzpyrazolyl as specified for Applicants' group Z. This

fact is conceded in the Final Office Action at page 4. Applicants also again point out that the examples of Lieb et al are limited to embodiments in which its group Y is 4-chlorophenyl. This is hardly surprising since, as mentioned above, the reference teaches a clear preference for optionally substituted phenyl groups having the

formula . The Final Office Action at pages 5-6 suggests that the closest

prior art would be found by selecting a compound having one of the Y groups found in Lieb et al at column 29 but, for some unexplained reason, the list provided in the Final Office Action did not include the first such group shown at column 29, which is

a substituted phenyl group having the formula . This group clearly

encompasses the very most preferred phenyl group discussed above. While Applicants acknowledge that they are obligated to carry out comparison experiments on the closest prior art compounds, the Final Office Action cites no authority – nor could Applicants' undersigned representative find such authority – that would require an applicant to pick and choose from among a host of possible substituents found in a reference to “invent” a compound not disclosed in the reference for purposes of comparison, much less cobble together for purposes of comparison a compound having specific groups not found in the reference (as is the case here for pyrazoles, which are not disclosed in the reference). Here, Applicants properly compared a compound of their invention with a compound not only disclosed in Lieb et al but one that is among the most preferred embodiments taught by the reference. Since it is well established that all embodiments disclosed in a reference can be presumed essentially equivalent unless the reference teaches some preference for certain embodiments, Applicants maintain that those skilled in the art would not be led to select for comparison a compound that is not only not among the preferred embodiments taught by the reference but is not even disclosed in the reference. In the absence of any teaching of a structurally more appropriate comparison compound (which here could be a pyrazole compound if such were found in the reference), it might be considered evasive and a possible violation of the duty of candor to select a comparison compound not believed to be among embodiments taught as preferred.

Second, even if one ignores the above arguments about Applicants' comparison choices, one should not ignore the well established principle that even structurally similar inventions can be patentably distinct under certain circumstances. E.g., *U.S. v. Adams*, 383 U.S. 39, 148 U.S.P.Q. 479 (1966). For example, a narrowly claimed invention is not rendered obvious merely because a reference discloses "compounds having a generic formula which would include [the claimed compounds] if proper selection from among the many possible variables were made as suitable for the claimed purpose," particularly where "the shotgun type approach of the reference . . . would not guide one skilled in the art to choose [applicants'] restricted class of compounds from among the host of possible combinations and permutations suggested by patentees." *Ex parte Strobel and Catino*, 160 U.S.P.Q. 352 (P.O. Bd. App. 1968) (emphasis added); see also *In re Baird*, 29 U.S.P.Q.2d 1550, 1552 (Fed. Cir. 1994). This principle is particularly applicable where the reference teaches a preference for compositions other than those claimed in the new application and where comparative evidence supports a finding of non-obviousness. E.g., *Ex parte Strobel*, 160 U.S.P.Q. at 352-353; see also *In re Chupp*, 816 F.2d 643, 646, 2 U.S.P.Q.2d 1437, 1439 (Fed. Cir. 1987), and *In re Cescon*, 474 F.2d 1331, 1333, 177 U.S.P.Q. 264, 266-267 (C.C.P.A. 1973).

Here, Declarants selected comparison compounds falling within the scope of the preferred embodiments as taught by Lieb et al. Applicants therefore respectfully submit that their comparison data not only fully comply with the established requirements for comparison experiments but also fully support their position that their claimed invention is patentably distinct from Lieb et al. For details of these experiments, Applicants again refer to their Amendment dated December 3, 2008.

Applicants therefore respectfully submit that their claimed invention is not rendered obvious by Lieb et al.

In view of the preceding amendments and remarks, allowance of the claims is respectfully requested.

Respectfully submitted,

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